

REMARKS

By this amendment, claims 1-4, 8-10, 12 and 14-22 have been canceled. The dependency of claims 11 and 13 have been changed to independent claim 5, and new method claims s 22-26 have been added.

Claim 5 was rejected under 35 U.S.C. §102(b) as being anticipated by Reiley et al., U.S. Patent No. 5,827,289. The Examiner did not give any patentable weight to “adapted for use ...” and “such that the suction ...” on the grounds that such recitations were deemed merely functional. Applicant respectfully disagrees.

A functional limitation must be evaluated and considered, just like any other limitation of the claim, for what it fairly conveys to a person of ordinary skill in the pertinent art in the context in which it is used. A functional limitation is often used in association with an element, ingredient, or step of a process to define a particular capability or purpose that is served by the recited element, ingredient or step. See MPEP 2173.05(g)

In the case at bar, claim 5 includes a limitation of a “second tube or lumen interconnecting the vacuum source to the grooves, recesses or depressions [thereby] causes a water-tight seal to be established between the periphery of the device and the inner wall of the lumen.” The Examiner would have to agree that this limitation, if considered, is not met by the cited reference. Applicant argues, however, that not only does this limitation distinguish over the prior art functionally, but also structurally. Insofar as the ‘289 patent does not include any apparatus performing a water-tight seal. Rather, “parts 12 and 14 have a suction tube 16 therebetween for drawing fats and other debris by suction into tube 16 for transfer to a remote disposal location.” Thus, apart from the fact that suction is used, the apparatus of the ‘289 patent lacks the physical configuration operative to form a water-tight seal, thereby precluding anticipation.

Claims 11 and 13 were rejected under 35 U.S.C. §103(a) over Reiley in view of Bonutti, U.S. Patent No. 5,321,975. The Examiner concedes that Reiley lacks an inflation pressure monitor, or a vacuum pressure monitor, but argues that it would have been obvious to one of ordinary skill in the art to include such a monitor to prevent damage to the bodily tissue. However, it is well settled that in rejecting claims under 35 U.S.C. §103, the Examiner must provide a reason why one having ordinary skill in the pertinent art would have been led to combine the cited references to arrive at Applicant’s

claimed invention. There must be something *in the prior art* that suggests the proposed combination, other than the hindsight gained from knowledge that the inventor choose to combine these particular things in this particular way. Uniroyal Inc. v. Rudkin-Wiley Corp., 837 F.2d 1044, 1051, 5 USPQ2d 1434, 1438 (Fed. Cir. 1988). The Examiner is also required to make specific findings on a suggestion to combine prior-art references. In Re Dembeczak, 175 F.3d 994, 1000-01, 50 USPQ2d 1614, 1617-19 (Fed. Cir. 1999).

In this case, there is no teaching or suggestion whatsoever in the primary reference of Reiley to monitor pressure, nor is there any teaching or suggestion in Bonutti to occlude a cardiovascular vessel or other body lumen. Accordingly, *prima facie* obviousness has not been established. Although the Examiner cites column 3, lines 56-59 of Bonutti, this is not for inclusion of a vessel, but rather, to stop blood flow from anastomosis or angioscopic procedure.

Claim 11 was rejected under 35 U.S.C. §103(a) over Reiley in view of Barbut, U.S. Patent No. 6,165,199. The Examiner concedes that Reiley lacks the teaching or suggestion of a suction over a monitor, but argues that it would have been obvious to include such a monitor as a means for regulating the pressure within the body lumen. However, given that Reiley does not teach or suggest the creation of a water-tight seal, there would be no reason for Reiley to monitor suction. That is, suction could be maintained on a continuous basis, which it no doubt is, to continue to remove fat and other bodily debris. Accordingly, *prima facie* obviousness has not been established with respect to this claim either.

Based upon the foregoing amendments and comments, Applicant believes all claims are in condition for allowance. To expedite prosecution, the Examiner may contact the undersigned attorney at the telephone or facsimile numbers provided.

Respectfully submitted,

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